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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/821,722	04/09/2004	Dave Whelan	040214-000100US	1512
20350 7590 03/09/2007 TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER SELLS, JAMES D	
			ART UNIT 1734	PAPER NUMBER

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/09/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/821,722

Applicant(s)

WHELAN, DAVE

Examiner

James Sells

Art Unit

1734

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10, 12-21, 23-32 and 34-41 is/are rejected.
- 7) ☒ Claim(s) 11, 22 and 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-10, 12-15, 18-21, 23-30, 32, 34 and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann et al (US Patent 5,938,890) in view of Ashcraft et al (US Patent 4,822,442).

Schlinkmann discloses a method and apparatus for removing components from a liner. The system comprises a roller device 3 adapted for moving the liner 26, gripper 12 adapted for selectively gripping the liner, and a placement actuator 13 to engage the desired component. Gripper 12 and actuator 13 are coupled through controller, which is adapted for moving the actuator when the roller device 3 moves the liner. The device of Schlinkmann also includes a base 22 against which the liner 26 is gripped by gripper 12, peeler 6, roller peeler edge 7 vacuum chuck 13, sensor 11, and air cylinder 10.

However, Schlinkmann does not teach the coupler adapted for moving the placement actuator in the manner claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Ashcraft.

Ashcraft discloses an apparatus for handling and positioning gummed articles. The apparatus includes a vacuum chuck 34 mounted within a transporter 48, which is

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mounted for movement along rail 49. The transporter 48 is arranged to move horizontally in the manner of applicant's claimed coupler.

It would have been obvious to one having ordinary skill in the art to employ a movable transporter or coupler, as taught by Ashcraft, in the method and apparatus of Schlinkmann in order to facilitate handling of the materials.

3. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann et al in view of Ashcraft et al as described above in paragraph 2 in further view of Vicktorius et al (US Patent 6,009,926).

Schlinkmann does not disclose having the actuator able to rotate the component on the target device as claimed by the applicant. Regarding this difference, the applicant is directed to the reference of Vicktorius.

Vicktorius discloses a labeling machine with a suction holder 3, which rotates to allow for more flexibility in the positioning of the label 4 onto the package 2.

It would have been obvious to one having ordinary skill in the art to have the actuator in Schlinkmann rotate because Vicktorius teaches that it is known to have the holder rotate to ensure the label is oriented properly on the package in the desired position.

4. Claims 17, 31, 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann et al in view of Ashcraft et al as described above in paragraph 2 in further view of McNestry (US Patent 6,368,446).

Schlinkmann teaches that the labels are generally supplied pre-printed or they may be printed in the label dispensing apparatus (see col. 1, lines 10-13). However, the method and device of Schlinkmann does not include printing the labels. Also, Schlinkmann does not disclose if the packages are conveyed past the actuator.

McNestry shows an apparatus where the labels 11 are printed by printer 26 after they are unrolled from a supply roll 25 and before the labels are peeled from a release liner and placed on a package 12. McNestry also shows it is known in the art to move the packages past an applicator on a conveyor.

It would have been obvious to one having ordinary skill in the art to include a printer in Schlinkmann if the artisan wishes to print the label before placing it on a package because this is taught by McNestry and Schlinkmann discloses that it is a well-known alternative to using pre-printed labels. In addition, it would have been obvious to one having ordinary skill in the art to move the packages past the actuator in Schlinkmann on a conveyor as is done in McNestry in order to facilitate feeding of the materials.

5. Claims 39-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schlinkmann et al in view of Ashcraft et al as described above in paragraph 2 in further view of Klein et al (US Patent 6,558,490).

Klein discloses a system and method for applying labels to products. As shown in Fig. 5, the system comprises system controller 232 for controlling various elements of

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the system including conveyor belt 202, roller 224, drive units 228 and 240 and conveyor encoder assembly 230. See col. 9, line 17 through col. 10, line 38.

It would have been obvious to one having ordinary skill in the art to employ a system controller, as taught by Klein, in the method and apparatus of Schlinkmann in order to provide more precise handling of the articles and labels during the labeling operation.

Response to Arguments

6. Applicant's arguments filed 8-17-06 have been fully considered but they are not persuasive.

Applicant argues Schlinkmann and Ashcraft do not show a removable coupling as claimed by the applicant. The examiner does not agree. Applicant's claims merely recite that the actuator is removably coupled with a coupler. Applicant is reminded that claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Schreiber*, 128 F.3d 1473, 1477-78, 44 USPQ2d 1429, 1431-32 (Fed. Cir. 1997). Applicant's functional language imparts limited structure to the claims. It is the examiner's position that the figures of Schlinkmann and Ashcraft show applicant's claimed elements coupled together. Since many types of coupling systems, such as screws and bolts, are *inherently* removable to some extent, it is the examiner's position that the disclosure of Schlinkmann in view of Ashcraft as described above meets applicant's claimed limitations.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, as stated above, it would have been obvious to one having ordinary skill in the art to employ a movable transporter or coupler, as taught by Ashcraft, in the method and apparatus of Schlinkmann in order to facilitate handling of the materials.

Applicant argues that Schlinkmann and Ashcraft do not show linear movement of the gripper. The examiner does not agree. Linear movement is shown by the transporter 48 of Ashcraft. Since this transporter is *capable* of transporting the gripper in the manner claimed, the examiner believes it meets applicant's claimed limitation. Therefore applicant's argument is believed to be incorrect in this instance.

Allowable Subject Matter

7. Claims 11, 22 and 33 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Telephone/Fax


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Sells whose telephone number is (571) 272-1237. The examiner can normally be reached on Monday-Friday between 9:30 AM and 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Fiorilla can be reached at (571) 272-1187. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


**JAMES SELLS
PRIMARY EXAMINER
TECH. CENTER 1700**